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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Walter P. Carney et al.

Serial No.: 08/321,179 Examiner: T. Scheiner

Filed: October 11, 1994 Group Art Unit: 1802

For: DETECTION AND QUANTIFICATION OF NEU RELATED PROTEINS IN THE BIOLOGICAL FLUIDS OF HUMANS

1185 Avenue of the Americas
New York, New York 10036
July 7, 1995

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

COMMUNICATION IN RESPONSE TO APRIL 7, 1995 OFFICE ACTION

This Communication is submitted in response to the Office Action issued April 7, 1995 in connection with the above-identified application, a response to which was originally due May 7, 1995. Applicants hereby request a two-month extension of time in connection with the subject application. Therefore, a response to the April 7, 1995 Office Action is due July 7, 1995. The required fee for the two-month extension of time is THREE HUNDRED AND SEVENTY DOLLARS ($370.00). A check in the amount of $370.00 is enclosed to cover the fee. Accordingly, this Communication is being timely filed.

In the April 7, 1995 Office Action the Examiner required restriction under 35 U.S.C. §121 to one of the following allegedly distinct and independent inventions:

I. claims 1 and 2, drawn to the human neu related peptide, p100, classified in Class 530, subclass 350; and

II. claims 3-12, drawn to immunoassays for the detection of p100 in tissues, cell and biological fluids, classified in Class 435, subclass 7.23; and

III. Claims 13-18, drawn to monoclonal antibodies specific for p100 and hybridomas which secrete the antibodies, classified in Class 530, subclass 388.85 and Class 435, subclass 240.27.

In response, applicants elect, with traverse, the invention Group I, claims 1 and 2 i.e. human neu related peptide.

Applicants maintain the Examiner's restriction requirement is improper. There are two requirements for a proper restriction requirement between two patentably distinct inventions: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required (M.P.E.P. §803).

The Examiner's restriction with regard to Groups I and II, the human neu polypeptide and the monoclonal antibody specific for p100 is unreasonable. Applicants acknowledge that Groups I and II are chemically distinct products. However, applicants maintain that the p100 peptide and the monoclonal antibodies to neu are used in such related manners that searching both groups would not be a serious burden for the Examiner. Specifically, having a peptide one skilled in the art may develop antibodies to the peptide. As the Examiner stated monoclonal antibodies to p100 could be used to affinity purify p100. Thus, a search of the p100 literature would locate p100 monoclonal antibodies and vis versa. Thus, there would be no additional burden on the Examiner to search both groups and the restriction requirement is improper.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

No fee, other than the $370.00 extension fee, is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

7/7/95
John P. White
Reg. No. 28,678
Date